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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|-------------------------|------------------|
| 10/077,723 | 02/14/2002 | C.J. Anthony Fernando | 02-02 US | 7904 |
| 23693 | 7590 | 02/10/2005 | EXAMINER PAK, SUNG H | |
| Varian Inc. Legal Department 3120 Hansen Way D-102 Palo Alto, CA 94304 | | | ART UNIT 2874 | PAPER NUMBER |

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/077,723 | Applicant(s) FERNANDO ET AL. | |
| | Examiner Sung H. Pak | Art Unit 2874 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-17, 22 and 25-48 is/are pending in the application.
 4a) Of the above claim(s) 25-48 is/are withdrawn from consideration.
 5) ☒ Claim(s) 12-17 and 22 is/are allowed.
 6) ☐ Claim(s) _____ is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 14 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1104</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/2004 has been entered.

All pending claims have been carefully reconsidered in view of the applicant's submission.

Information Disclosure Statement

Information disclosure statement filed 11/22/2004 has been considered by the examiner.

Election/Restrictions

Applicant's traversal of election by original presentation in the reply filed on 8/23/2004 is acknowledged. The traversal is on the ground(s) that 1)"subclasses 15 and 16 cover very similar subject matter" 2) examination of both groups does not pose a serious burden on the examiner 3) "claims 25-38, 43 and 44 would have been classified in the same class as claims 1-11 and 23, for which a search and examination have already been made."

As stated in the Advisory Action mailed on 11/02/2004, this is not found persuasive because :

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1) Even if we assume, for the sake of argument, that subclasses 15 and 16 indeed cover very similar subject matter, the restriction requirement is proper because the particulars of the subcombination as claimed are not required for patentability of the combination as claimed in the instant application. As such, the search and analysis of these two groups of claims would inherently involve two patentably distinct sets of limitations. Therefore, search and analysis required for one group is not required for the other group, and the restriction is proper. MPEP 806.05(c).

2) As discussed above, the examination of both groups cannot involve a single search. Even if both groups CAN be classified in a single common subclass, the actual search for recited limitations involves searching of plurality of subclasses (such as subclass 12, 15, 16, 25, 26, etc.), including various text search strategies. Conducting a search for two patentably distinct inventions with distinct and independent limitations pose serious burden on the examiner and the restriction is proper.

3) The original claims 1-11 and 23 (which were subsequently cancelled in an earlier amendment) involve different scope and permutations of limitations compared to the newly added claims 25-38, 43 and 44. Thus, the same search and analysis performed for the original claims 1-11 and 23 no longer applies to the newly added claims 25-48, and the restriction is proper.

The requirement is still deemed proper and is therefore made FINAL.

Allowable Subject Matter

Claims 12-17, 22 are allowed.

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The following is a statement of reasons for the indication of allowable subject matter:

An apparatus for selectively routing optical signals over plurality of optical channels are well known in the art. Also, an apparatus routing optical signals utilizing rotatable optical coupling mechanism is known in the art.

Kassel et al (US 3,697,185) discloses the most relevant prior art, wherein a rotating "light pipe scanner" is used to route optical beams through plurality of colorimetry samples (Fig. 8). The light pipe scanner spins at a predetermined rotation rate, and the optical beam is distributed through the rotating mechanism (Fig. 8 and column 5 lines 62-67). However, none of the prior art fairly teaches or suggests such an optical signal routing apparatus comprising, inter alia, a rotary element having an internal optical fiber disposed therein, wherein the rotary element rotates and aligns the fiber ends of the internal fiber to a *selected one of plurality of available optical channels* whereby returning optical signal from the test sample is routed through an optical return line corresponding to the optical channel, wherein each of the optical return line is fixedly supported by a mounting member on a base, as claimed in the instant application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sung H. Pak whose telephone number is (571) 272-2353. The examiner can normally be reached on Monday- Friday, 9AM-5PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sung H. Pak
Examiner
Art Unit 2874

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